

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-7, 9-13, 15 and 16 are pending in the application, with claims 1 and 10 being the independent claims. Claims 1 and 10 have been amended to correct minor issues with their form. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Request for clarification

Applicants note that the Office Action included claims 3-5, 9, and 11-13 in the rejection under 35 U.S.C. §103 (a) over the combination of Fishbine and Kurase. Under this ground of rejection, no specific details were provided for the rejection of these claims. However, the Office Action also stated that claims 3-5 and 11-13 were rejected under 35 U.S.C. §103 (a) over the combination of Fishbine, Kurase, and Casey. In addition, claim 9 was rejected over the combination of Fishbine, Kurase, and Geiger. In the following response, Applicants have assumed that claims 3-5, 9, and 11-13 were rejected under both combinations. If this assumption is incorrect, Applicants request that the Examiner issue a corrected non-final Action resetting the date for response.

Rejections under 35 U.S.C. § 112

Claims 1 and 10 were rejected under 35 U.S.C. §112, second paragraph. Specifically, the Office Action states that "the limitation 'said fingerprint scanner' in line 7" of Claim 1 and "the limitation 'the data and communication interface' in line 7" of Claim 10" lack sufficient antecedent basis in their respective claims. Applicants have amended Claim 1 on line 7 to recite "said mobile, hand-held fingerprint scanner" and Claim 10 on line 7 to recite "said data and power communication interface." Reconsideration and withdrawal of the ground of rejection is therefore respectfully requested.

Rejections under 35 U.S.C. § 103

Fishbine and Kurase

Claims 1-7, 9-13, 15, and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fishbine, *et al.*, U.S. Patent No. 5,467,403 (Fishbine), in view of Kurase, U.S. Patent No. 6,298,395. Applicants respectfully traverse this rejection.

In order to establish a *prima facie* case of obviousness, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." MPEP §2142. Applicants submit that a suggestion or motivation to combine the references to achieve Applicants' invention is not present.

Fishbine describes a fingerprint scanning device. In Fishbine, data appears to be transmitted from a portable image collection unit 10 to the base station unit 8 via data transmission interface 9. (Fishbine, Col. 3, lines 18-24; *See also* Fig. 1). Data

transmission interface 9 can apparently be a tether cable (Fishbine, Col. 7, lines 35-37).

Fishbine also shows a charger/cradle 34 in FIG. 1, and states "unit 10 sits in charger/cradle 34 when not in use. When unit 10 is removed from charger/cradle 34, it powers up and can be used to acquire images." (Fishbine, Col. 4, lines 23-26).

Thus, in a tethered embodiment for Fishbine, data is transferred via data transmission interface 9, and not through a docking station, as recited in claim 1 of the present invention.

Fishbine describes a rechargeable battery pack connected to the image collection unit 10 for "all non-tether data transfer embodiments." As stated in Fishbine, "a rechargeable battery pack is connected to unit 10 through the center channel adapter." (Fishbine, Col. 7, lines 54-61). Thus, the rechargeable battery pack is not integrated into the image collection unit 10 in Fishbine. Nowhere does Fishbine teach or suggest that the rechargeable battery pack is charged over the data transmission interface 9, whether or not interface 9 is coupled through a docking station in a non-tethered embodiment. Thus, in a non-tethered embodiment, Fishbine fails to teach or suggest power being provided to charge an interface charged rechargeable power supply through a docking station, as recited in claim 1.

Thus, Fishbine does not teach or suggest every element of claim 1. Furthermore, Kurase does not provide the missing teachings. Still furthermore, a motivation to combine Fishbine and Kurase is not present.

In the Office Action, the Examiner states that "Kurase teaches a mobile hand-held scanner." (Office Action, page 4). Applicants respectfully disagree with the Examiner's understanding of Kurase. Kurase teaches a digital camera 80. (Kurase, Col. 10, lines 39-46). Kurase does not provide any details on the implementation of the digital camera

and states that "[t]hough the digital camera 80 includes a variety of circuits, they are not illustrated here as they have no direct bearing upon the present invention." (Kurase, Col. 10, lines 56-57). Thus, from the limited details available in Kurase, Applicants submit that a motivation to combine Kurase and Fishbine is not discernable from Kurase.

Furthermore, as depicted in FIG.1, the fingerprint scanner in Fishbine includes a scanning camera 18 and a video camera 20. (Fishbine, FIG. 1). Fishbine teaches that the scanning camera "continuously images fingerprint images ... resulting in an image representative of the light reflected from parts of the finger 50 in contact with the image receiving surface 40." (Fishbine, Col. 5, lines 57-61). Fishbine describes that the scanning camera 18 and the video camera 20 can be any commercially available *video* camera, not a single-frame capture camera. (Fishbine, Col. 5, lines 66-67). However, Fishbine further describes that even the commercially available *video* cameras have shortcomings when used in fingerprint scanning applications. (Fishbine, Col. 6, lines 7-43).

In light of at least the different functions and operating requirements taught by Kurase and Fishbine, a suggestion or motivation for their combination is not present. Therefore, claims 1 and 10 are patentable over the combination of Fishbine and Kurase for at least the above reasons.

In the Office Action, the Examiner does not point to any suggestion or motivation in the references themselves, but instead states that "it would have been obvious to a person of ordinary skill in the art to apply Kurase's avoiding a dedicated plug for recharging a power supply separate from a data interface to Fishbine's fingerprint scanner. A motivation for doing so would have been to take advantage of power supply lines existing in a communication channel for recharging a battery" (Office Action, p.

4). However, "the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). As described above, neither references suggest the desirability of the combination.

Applicants further assert that this statement of the Office Action does not clearly provide a suggestion of the desirability of doing what the inventors have done. M.P.E.P § 2142 states:

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Applicants assert that such a suggestion has not been clearly provided for combining Fishbine and Kurase, but instead a mere conclusion has been provided. Applicants note "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious" *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992). Thus, Applicants respectfully request that suggestion be provided, presenting a convincing line of reasoning, or that the claims be passed to allowance.

For at least these reasons, claims 1 and 10 are patentable over the combination of Fishbine and Kurase. Claims 2-7 and 9 which depend from independent claim 1, and claims 11-13, 15, and 16, which depend from independent claim 10, are likewise

patentable over the cited references for at least the reasons provided above, and further in view of their own features. Accordingly, Applicants respectfully request that the rejection of claims 1-7, 9-13, 15, and 16 be reconsidered and withdrawn.

Fishbine/Kurase and Casey

Claims 3-5 and 11-13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fishbine and Kurase in view of Casey, U.S. Patent 6,011,486 (Casey). Claims 3-5 depend from claim 1 and claims 11-13 depend from claim 10. Casey does not overcome all of the deficiencies of Fishbine and Kurase relative to claims 1 and 10, described above. For at least these reasons, and further in view of their own features, claims 3-5 and claims 11-13 are patentable over the combination of Fishbine and Kurase in view of Casey. Reconsideration and withdrawal of the ground of rejection is therefore respectfully requested.

Fishbine/Kurase and Geiger

Claim 9 was rejected under 35 U.S.C. §103(a) as being unpatentable over Fishbine and Kurase in view of Geiger, U.S. Patent 6,154,010 (Geiger). Claim 9 depends from claim 1. Geiger does not overcome all of the deficiencies of Fishbine and Kurase relative to claims 1 and 2, described above. For at least these reasons, and further in view of its own features, claim 9 is patentable over the combination of Fishbine and Kurase, in view of Geiger. Reconsideration and withdrawal of the ground of rejection is therefore respectfully requested.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read "J. S. Weaver", followed by a horizontal line.

Jeffrey S. Weaver
Attorney for Applicants
Registration No. 45,608

Date: September 13, 2004

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600